RECORD AND BRIEFS

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In The
Supreme Court of the United States

MICHELLE K. LEE, DIRECTOR, UNITED STATES PATENT AND TRADEMARK OFFICE,

Petitioner,

v.

SIMON SHIAO TAM,

Respondent.

On Writ Of Certiorari To The United States Court Of Appeals For The Federal Circuit

BRIEF OF LAW PROFESSORS AS *AMICI CURIAE* IN SUPPORT OF THE PETITIONER

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INTEREST OF *AMICI CURIAE*

This brief is filed on behalf of the undersigned Law Professors identified in Appendix A. *Amici* are scholars at U.S. law schools whose research and teaching focus is intellectual property law. *Amici* have no direct interest in the outcome of this litigation. *Amici* are concerned that the Court of Appeals for the Federal Circuit's decision below – that all content-based determinations in trademark law must survive strict scrutiny – would wreak havoc on trademark law. We wish to bring to the Court's attention the implications of such a rule on trademark law.[1]

SUMMARY OF THE ARGUMENT

The Federal Circuit's ruling that the § 2(a) disparagement provision is unconstitutional, if upheld, could allow for numerous provisions of the Trademark Act to be overturned, dismantling the modern trademark system. The trademark system is premised on evaluating speech and making content-based determinations. Granting a trademark registration requires content-based determinations, though not viewpoint-based, as

[1] Pursuant to Rule 37.6, *Amici* affirm that no counsel for a party authored this brief in whole or in part and that no person other than *Amici* and their counsel made a monetary contribution to its preparation or submission. Petitioner's and Respondent's consent to the filing of amicus briefs is filed with the Clerk. The Parties were timely notified of the intent to file this amicus brief pursuant to Rule 37.2. *Amici's* institutional affiliations are provided only for purposes of identification.

words are evaluated independent of applicants' individual viewpoints.

In no way does the refusal to register a trademark prevent its use or diminish public debate. Rather than facilitating public debate, a trademark registration is a government-issued document that makes it easier for its owner to suppress the speech of others. A trademark registration is not an entry pass to the forum; it is a right to exclude. Thus in trademark law whether the government refuses registration to a mark owner or it arms that owner with a registration to enforce against other speakers, the government inevitably interferes in someone's speech.

The Federal Circuit's mistake was to treat a regulatory, benefit-granting program as if it were a ban on speech. Although prohibiting the *use* of disparaging marks would suppress speech, the government does not suppress speech by refusing to include these marks on the federal register. If a firm wants to use the N-word as its mark, it is free to do so under trademark law. Instead of doctrines focused on banned speech, the unconstitutional conditions doctrine is a more appropriate test for the trademark registration system, and because registration does not attempt to affect a registrant's speech outside the four corners of the registration it poses no First Amendment problem.

The different justifications, functioning, and risks of registration compared to laws punishing speech make application of doctrines about banning speech to the Lanham Act both incoherent and unwise. To rule

otherwise would jeopardize much of the structure of trademark law.

ARGUMENT

I. THE FEDERAL CIRCUIT'S DECISION WRONGLY TREATS TRADEMARK REGISTRATION REFUSAL AS A BAN ON SPEECH.

In its decision below, the Federal Circuit acknowledged that its decision put other provisions of the Lanham Act in jeopardy. Although its specific holding was limited to the refusal of registration for disparaging marks under 15 U.S.C. § 1052(a) [§ 2(a)], the en banc court made clear that its analysis would require reconsidering "the constitutionality of other portions of § 2 in light of the present decision." *In re Tam*, 808 F.3d 1321, 1130 n.1 (Fed. Cir. 2015). This is no idle threat. If the Federal Circuit's ruling stands, much of the screening that the United States Patent and Trademark Office [USPTO] performs could also be found unconstitutional, and many aspects of the current regime, from incontestability[2] to intent-to-use

[2] The result of incontestability is that "trademarks" with no meaning in the marketplace may be used to suppress others' uses of descriptive terms, despite the fact that consumers could not be harmed by such uses. *Park 'N Fly, Inc. v. Dollar Park & Fly, Inc.*, 469 U.S. 189, 207-09 (1985) (Stevens, J., dissenting); Rebecca Tushnet, *The First Amendment Walks into a Bar: Trademark Registration and Free Speech*, 91 Notre Dame L. Rev. (forthcoming 2016) (manuscript available at https://papers.ssrn.com/sol3/papers.cfm?abstract_id=2745016).

applications,[3] to the infringement standard itself, would be threatened. This widespread vulnerability suggests that the Federal Circuit's treatment of the Lanham Act's regulatory scheme as presumptively unconstitutional is misguided.

A. Trademark Law Is Pervasively Content-Based.

The Federal Circuit held that all regulations of speech that depend on an evaluation of the content of the speech to determine whether the regulation has been violated are content-based and must survive strict scrutiny. *In re Tam*, 808 F.3d at 1335 ("It is beyond dispute that § 2(a) discriminates on the basis of content in the sense that it 'applies to particular speech because of the topic discussed,'" *citing Reed v. Town of Gilbert*, 135 S. Ct. 2218, 2227 (2015).). But if strict scrutiny applies whenever a program of government benefits for specific kinds of commercial speech demands content determinations, then much of § 2, and possibly much more than that, is unconstitutional.

In addition to the bar on disparaging marks, § 2 prohibits the registration of any mark that is: scandalous; immoral; deceptive; falsely suggestive of a connection with persons, institutions or religions; likely to cause confusion with an existing mark; descriptive;

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[3] The Lanham Act's intent-to-use provisions allow claimants to assert rights in advance of any use – that is, before consumers form any beliefs about the source of products or services bearing the mark, and thus before they could actually be confused by competing uses, changing the common law first-to-use rules.

misdescriptive; functional; a geographic indication for wine or spirits other than the place of origin of the goods; government insignia; a living person's name, portrait or signature without written consent; or a surname. 15 U.S.C. §§ 1052(a-e). Nor, because § 2 requires that a mark be distinctive, may generic symbols be registered. *Id.* at § 1052 (limiting registration to trademarks "by which the goods of the applicant may be distinguished from the goods of others"); *Park 'N Fly, Inc. v. Dollar Park & Fly, Inc.*, 469 U.S. 189, 194 (1985). Most of these bars have been in place since the inception of the federal trademark registration program in 1905,[4] and are routinely applied by the USPTO.

This broad list of bars to registration serves a number of policies that go well beyond protecting consumers from deception in the marketplace. A number of the bars deal with confusing or deceptive marks.[5] Some bars, and the prohibition on registering generic symbols, relate to another central concern of trademark law: competition.[6] Significantly, however, a number of the bars apply to marks that are neither

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[4] The disparagement bar was enacted in 1946, as part of the Lanham Act's original text. Trademark Act of 1946, ch. 540, title I, § 2, 60 Stat. 427.

[5] Specifically, the bars for marks that are deceptive; falsely suggestive of a connection with persons, institutions or religions; likely to cause confusion with an existing mark; and primarily geographically deceptively misdescriptive directly implicate deception.

[6] The bars for marks that are descriptive, misdescriptive, merely a surname, and functional limit the monopolization of words and designs that competitors may desire to use in commerce.

confusing/deceptive nor anticompetitive on their face. These include the disparaging, scandalous, and immoral bars, but also include the bars on inaccurate but not necessarily misleading geographical indications of origin for wine or spirits, names of specific living persons absent written consent, and government insignia.[7] These bars relate to other policy concerns. What the Federal Circuit observed of disparagement is equally true of the competition-related and other non-deception-related bars:

> [t]hese latter restrictions cannot be justified on the basis that they further the Lanham Act's purpose in preventing consumers from being deceived. These exclusions from registration do not rest on any judgment that the mark is deceptive or likely to cause consumer confusion, nor do they protect the mark-holder's investment in his mark.

In re Tam, 808 F.3d at 1329. These bars, including the disparagement bar, do target categories of symbols that are less likely to serve the trademark function than other symbols because of the additional meanings

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[7] Section 2(b), for instance, bars marks consisting of flags, coats of arms, or "other insignia of the United States, or of any State or municipality, or of any foreign nation." 15 U.S.C. § 1052(b). These bans are effectuated on a per se basis. This list of banned insignia represents institutions that Congress presumably thought should be spared *any* commercial appropriation, not just instances that would sully these symbols based on the particular use involved. *Renna v. County of Union*, 88 F. Supp. 3d 310, 320-21 (D.N.J. 2014) (discussing the free speech interests involved in making insignia unregistrable); Christine Haight Farley, *Stabilizing Morality in Trademark Law*, 63 Am. U. L. Rev. 1019, 1037-38 (2014).

they carry that can overwhelm or detract from potential source-signifying function. *See* Michael Grynberg, *A Trademark Defense of the Disparagement Bar*, 126 Yale L.J. Forum 178 (2016), http://www.yalelawjournal.org/forum/a-trademark-defense-of-the-disparagement-bar. Nonetheless, they are not centrally about deception. For example, the bar on registering symbols that merely truthfully describe the applicant's goods and services is obviously content-based, and it is also clearly not about deception. The descriptiveness bar, like the others, is connected to the broader policy goals of trademark law, but that is to say that registration, and the registration bars, serve government interests beyond deception.

To determine whether the mark itself, or matter contained within the mark, corresponds to any of the bars in § 2, the USPTO must evaluate the content of the mark, with the exception of the bar on utilitarian functionality.[8] Thus, just as the bar at issue in this case

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[8] The functionality bar in § 2(e)(5) does not require the USPTO to decipher a meaning from the applied-for design. 15 U.S.C. § 1052(e)(5). Aesthetic functionality, however, requires a determination of the aesthetic value of a design. Thus, registration may hinge on a determination of what the design depicts, *Int'l Order of Job's Daughters v. Lindeburg & Co.*, 633 F.2d 912, 919 (9th Cir. 1980) (finding that the applied-for design was the emblem of a young women's fraternal organization), or what the design conveys, *In re Florists' Transworld Delivery, Inc.*, No. 77590475, 2013 WL 2951796, at *9-10 (T.T.A.B. Mar. 28, 2013) (finding that the color black communicates particular messages such as luxury and elegance, or grief and condolence, and that the color of floral packaging can be just as important as the color of the flowers themselves in conveying such messages.).

requires the government to evaluate the meaning of Mr. Tam's mark in the context of his services, so too do these other bars. For instance, if an applicant applies for a registration of the word mark BRAMLEY, the USPTO must determine if that word would be understood by a substantial number of consumers as the name of a living person, a place, or a surname. *In re Quadrillion Publ'g Ltd.*, No. 75/217,892, 2000 WL 1195470, at *1-2 (T.T.A.B. Aug. 9, 2000). Likewise, in determining whether a word or words are confusing, deceptive, descriptive or misdescriptive, the USPTO must first parse the meaning of the word to its audience. Nor is this task limited to words. Consider § 2(b), which requires the USPTO to determine whether an applied for design is a "simulation" of an existing flag. *See In re Old Glory Condom Corp.*, 26 U.S.P.Q.2d 1216 (T.T.A.B. 1993).

B. Section 2 Disparagement, Like Defamation Law, Is Content-Based But Viewpoint-Neutral.

The Federal Circuit treated disparagement as distinguishable from the other § 2 bars because it found disparagement to be not only content-based but also viewpoint-based. *In re Tam*, 808 F.3d at 1335. However, the line between content- and viewpoint-based regulation is not helpful without a theory of why the particular regulation at issue exists. *See, e.g.*, *Rosenberger v. Rector & Visitors of Univ. of Va.*, 515 U.S. 819, 831 (1995) (noting that the distinction between content and viewpoint discrimination "is not a precise one");

Geoffrey R. Stone et al., *Constitutional Law* 1765 (3d ed. 1996) ("That it is unconstitutional for the government to act for the purpose of promoting speech favoring the Democrats (as opposed to, say, the Republicans) does not necessarily entail that it is unconstitutional for it to act . . . for the purpose of promoting speech favoring democracy (as opposed to, say, totalitarianism).").

Given the meaning of "disparagement" as a concept that could apply to anyone, the ban on disparaging marks is more appropriately characterized as content-based rather than viewpoint-based. Section 2(a) prohibits registration of a mark that disparages anyone, abortionist or anti-choice zealot. *See Ridley v. Mass. Bay Transp. Auth.*, 390 F.3d 65, 82-87 (1st Cir. 2004) (considering ban on disparaging subway ads). The Federal Circuit en banc majority claimed that "[t]he legal significance of viewpoint discrimination is the same whether the government disapproves of the message or claims that some part of the populace will disapprove of the message." *In re Tam*, 808 F.3d at 1336. If the "part of the populace" at issue were static and unchanging no matter what mark was at issue, that might be true. However, because the "part of the populace" whose views are considered changes depending on the specifics of the applied-for mark, no particular group or set of viewpoints receives protection denied to everyone else. *See id.* at 1372 (Dyk, J., concurring and dissenting) (quoting *Davenport v. Wash. Educ. Ass'n*, 551 U.S. 177, 189 (2007)) ("[T]he standard is not based on the *government's* disagreement with anything.

Rather, it is based on an objective, 'neutral' assessment of a non-government perspective – in this case, a 'substantial composite of the referenced group.' . . . [T]here is no 'realistic possibility that official suppression of ideas is afoot.'"). Like defamation, which is content-based but not viewpoint-based, the disparagement bar protects everyone. In the world of trademark registration, no one is licensed to fight freestyle; we are all "to follow Marquis of Queensbury rules" in our registered trademarks. *R.A.V. v. City of St. Paul*, 505 U.S. 377, 391 (1992); *see also* Lisa P. Ramsey, *A Free Speech Right to Trademark Protection?*, 106 Trademark Rep. 797, 876-77 (2016).

Furthermore, viewpoint discrimination in the past has been tied to the viewpoint of the person who is losing out because of her speech, such as a speaker denied school funding because *her* viewpoint was religious instead of nonreligious. *See Rosenberger v. Rector & Visitors of Univ. of Va.*, 515 U.S. 819, 831 (1995). By contrast, the disparagement exclusion denies registrations equally to people trying to disparage a group and to people trying to reclaim terms on behalf of the disparaged group, as long as a substantial composite of the referenced group would see the term as disparaging. *See R.A.V. v. City of St. Paul*, 505 U.S. at 391 (a hypothetical statute that prohibited "odious racial epithets . . . to proponents of all views" would not discriminate on basis of viewpoint). Thus, the disparagement bar is also neutral as to the applicant's membership in and viewpoint on the particular disparaged group at issue. *See Boos v. Barry*, 485 U.S. 312, 315-19 (1988)

(plurality) (upholding law against display of any sign within 500 feet of a foreign embassy if the sign would tend to bring that foreign government into "public odium" or "disrepute"; restriction was not viewpoint-based because looking at policies of foreign governments was neutral method of identifying covered speech); *Ridley*, 390 F.3d at 90 ("[G]uidelines prohibiting demeaning or disparaging ads are themselves viewpoint neutral."); *id.* at 91 ("[T]he state is not attempting to give one group an advantage over another in the marketplace of ideas."). *Cf. Ark. Educ. Television Comm'n v. Forbes*, 523 U.S. 666, 683 (1998) (denying participation in political debate to candidate with minimal public support was not viewpoint-based, because participation would be denied to anyone who lacked sufficient support, no matter what views he held). So, for example, if an applicant applied for CELEBRASIANS for an advocacy group that sought to bar Asian immigration, the mark would not be disparaging even if the group's intention was disparaging.

The *In re Tam* majority's error was to find viewpoint discrimination because the bar relies on determining what a group of people understands the meaning of a term to be, in context. The error of conflating the speaker's viewpoint with the audience's understanding, if left undisturbed, would indicate that the deceptiveness and descriptiveness bars are also viewpoint-based. *See* Ned Snow, *Free Speech and Disparaging Trademarks*, 57 B.C. L. Rev. 100, 145 (2016). Terms that convey materially false meanings about a good or service are unregistrable (regardless of the

presence of an intent to deceive), *In re Budge Mfg. Co.*, 857 F.2d 773, 775 (Fed. Cir. 1988), but misdescriptive terms that have secondary meaning are registrable so long as consumers do not find the misdescription to be material to their purchasing decision. 15 U.S.C. § 1052(f), while terms that accurately describe the goods or services with which they are used can only be registered with secondary meaning. *Id.* All of these rules require subjective, observer-based inquiries dependent on what the audience believes and considers important, just as the perception of the target group makes the difference for disparagement.

The regulatory nature of trademark registration is vital here because each individual decision is based on the specifics of what the applicant is applying for. Each individual decision may involve a viewpoint, but the law itself does not judge based on viewpoint. Nor, again, does it matter what the applicant's identity or viewpoint is, as long as the targeted group would find the mark disparaging. Trademark law simply does not care about the applicant's views. *See In re Heeb Media, LLC*, 89 U.S.P.Q.2d 1071, 1077 (T.T.A.B. 2008) (holding that the determination of the meaning of the mark centers on the referenced group's perception of the term rather than the applicant's intentions.)

C. Precedents Involving Bans On Speech, Even Commercial Speech Precedents, Do Not Make Sense For Trademark Law.

The Federal Circuit's mistake was to treat a regulatory, rights-granting program as if it were a punishment for speech, rather than a government program awarding rights to control commercial speech to one private party: rights that allow the registrant to suppress the speech of others. The different justifications, functioning, and risks of registration compared to laws punishing speech make application of precedents involving punishment for speech to the Lanham Act both incoherent and unwise.

Reed, on which the Federal Circuit relied, evaluated a prohibition on speech. *Cent. Hudson Gas & Elec. v. Pub. Servs. Comm'n of N.Y.*, 447 U.S. 557 (1980), another case invoked by the Federal Circuit, likewise establishes a four-part test to determine if bans on commercial speech survive First Amendment scrutiny. The first step in the inquiry asks whether the speech at issue is false or misleading; if so, it may simply be banned. Several consequences follow for evaluating trademark law: first, *Central Hudson*, like *Reed*, is not appropriate for evaluating a discretionary government act. Second and relatedly, as detailed in Part II.A., trademarks as such are neither truthful nor deceptive without legal recognition of trademark rights, making traditional *Central Hudson* analysis difficult at best.

Moreover, trademark law has not limited itself to speech meeting the definition of "commercial speech"

used in First Amendment cases. Courts have found infringement in books, *Penguin Books USA, Inc. v. Dr. Seuss Enters.*, 521 U.S. 1146 (1997), parody magazines, *Balducci Publ'ns v. Anheuser-Busch, Inc.*, 513 U.S. 1112 (1995), art, *Romm Art Creations Ltd. v. Simcha Int'l, Inc.*, 786 F. Supp. 1126 (E.D.N.Y. 1992), and songs, *Parks v. LaFace Records*, 329 F.3d 437 (6th Cir. 2003)[9] – and even when they have not found infringement in such cases, they have generally not relied on the fact that the challenged speech is noncommercial to take it outside the scope of the Lanham Act, instead developing special tests to deal with possible trademark infringement in noncommercial speech. *See, e.g., Rogers v. Grimaldi*, 875 F.2d 994, 999-1000 (2d Cir. 1989). Thus, when a trademark registration is issued by the government, the registrant is better able to suppress the speech of others – a situation that itself triggers First Amendment concerns about the scope of the resulting right.[10] *See N.Y. Times Co. v. Sullivan*, 376 U.S. 254 (1964). Even if the suppression is only of commercial speech, that too is of constitutional moment under

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[9] Many members of *Amici* consider these cases to have the wrong outcomes, but *Amici* here emphasize that the Lanham Act is a broad and multifaceted statute, and a First Amendment ruling on registration should recognize that scope.

[10] *See, e.g., San Francisco Arts & Athletics, Inc. v. United States Olympic Comm.*, 483 U.S. 522 (1987) (enjoining the San Francisco Arts & Athletics, Inc. from using the word "Olympic" in the promotion of the "Gay Olympic Games"); *MGM-Pathe Commc'ns v. Pink Panther Patrol*, 774 F. Supp. 869 (S.D.N.Y. 1991) (enjoining the use of "Pink Panther Patrol" to a group of gay rights activists for their anti-violence campaign).

Central Hudson. (In other words, if the speech suppressed by trademark enforcement is unimportant because it is commercial, then so too is the registrant's speech.)

Thus, unlike the classic speech ban against which most First Amendment doctrine is directed, no matter what decision the government makes in applying the bars of § 2, it will inhibit someone's speech – either the mark owner's, or everyone else's. Registration even goes beyond whatever rights might have existed at common law, providing, for example, nationwide rights in advance of any local use, and protection against invalidation for lack of secondary meaning after five years. 15 U.S.C. § 1057(c); 15 U.S.C. § 1065. In the issuance and refusal of trademark registrations there is no such thing as neutrality. The government has decided to shape the market for speech by regulating trademarks.

II. DENIAL OF REGISTRATION IS NOT A PUNISHMENT FOR SPEECH.

Trademark rights are not created through registration; they are acquired through the use of a distinctive mark in commerce.[11] Rather than being a penalty

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[11] *Amici* do not believe that the constitutionality of the disparagement bar ought to turn on whether § 43(a) protection is available for an unregistrable mark. At a minimum, the Court should recognize that registration may be unavailable on many absolute grounds, such as lack of use by the applicant as a trademark; lack of use by the applicant in U.S. commerce; functionality; deceptiveness; and genericity, as well as on the relative ground of

imposed on an actor doing business independently of the government, denial of registration requires interaction with the government. Absent government action, there can be no registration. Given that baseline, unconstitutional conditions analysis is the most appropriate doctrine to assess registration.

A. Registration Is Discretionary, And Directed Only At The Trademark Function, Not At Other Meaning.

Although registration is not a traditional monetary subsidy as in many unconstitutional conditions cases, the subsidy label is simply a way to identify government acts that do not impose penalties and thus may be appropriate even if content-based. Unconstitutional conditions doctrine recognizes that the government has more freedom to pick and choose beneficiaries where a private entity has no preexisting right to the benefit.[12] Government may not deny benefits based on an entity's speech outside the boundaries

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likely confusion with an existing mark already in use in the U.S. Whether, or when, one entity should be able to use § 43(a) to prevent another from using an unregistrable symbol involves both questions of statutory interpretation and of the policies underlying bars on registration, and the Court should not give a casual answer to that complex question in a case in which the question is only subsidiary. *Belmora LLC v. Bayer Consumer Care AG*, 819 F.3d 697, 708-09 (2016) pet'n for cert. filed No. 16-548 (Oct. 20, 2016); *Renna v. County of Union*, 88 F. Supp. 3d 310, at 320.

[12] Government speech is strongly related to unconstitutional conditions – the relevant considerations are similar, but unconstitutional conditions may better encompass the different ways in which government may carry out its aims.

of a government-funded program, and it may not discriminate based on viewpoint, but it may pursue goals that require it to evaluate content.

Under an unconstitutional conditions analysis, the government's legitimate options are defined by the nature of the program. In trademark registration, the program is to include on the register those marks that identify source – a specific function of symbols – so long as they do not run afoul of a statutory bar. *Bongrain Int'l (American) Corp. v. Delice de France, Inc.*, 811 F.2d 1479, 1485 (Fed. Cir. 1987). In 1979, this Court recognized that trademarks have "no intrinsic meaning." *Friedman v. Rogers*, 440 U.S. 1, 12 (1979). Unlike copyright law, trademark law does not protect symbols as such. Instead, trademark protects only symbols' source designating function, which can only be assessed contextually in relation to particular goods or services to which they are applied. "Apple" does not intrinsically designate a computer company; neither does "Microsoft"; "Google" once was the name of a search engine company but now is only the name of its most popular service.

Because trademarks do not have intrinsic source-indicating content, the Lanham Act regulates the symbol only in its role as a source identifier and the other functions of symbols are not implicated by trademark law. The primary drafter of the Lanham Act, Edward Rogers, put it this way:

> [T]he trade mark in and by itself is of little importance[;] it is but the visible manifestation of a much more important thing, a business good will[;] the good will is the substance, the trade mark merely the shadow, and . . . this business good will is the property to be protected against invasion.

Edward S. Rogers, *Comments on the Modern Law of Unfair Trade*, 3 Ill. L. Rev. 551, 555 (1909) (footnote omitted); *see also* Beverly W. Pattishall, *Trade-Marks and the Monopoly Phobia*, 50 Mich. L. Rev. 967, 971 (1952) ("[B]asically it is the intangible thing, the individual identity, which must be protected – as may be necessary – not any individual word or mark, as such, which is relied upon to achieve that identity.").

In First Amendment terms, the truth value of source indication, which is the only meaning that trademark law regulates, cannot be determined in the abstract. Felix S. Cohen, *Transcendental Nonsense and the Functional Approach*, 35 Colum. L. Rev. 809, 815 (1935) (explaining that trademark value stems from the willingness of the government to suppress unauthorized uses on the trademark claimant's behalf). Unlike ordinary communication, where changing the words can change the meaning, *Cohen v. California*, 403 U.S. 15, 25-26 (1971), a change of mark does not change the link between the mark and the trademark function, which is the only thing trademark law regulates. Google *is* Alphabet. And it is Alphabet, the legal entity, even though it continues to be called Google in everyday parlance.

The government has no interest in assigning the ownership of the non-trademark meaning of a symbol. Whether a term is arbitrary (apple for computers), suggestive (ivory for soap), or fanciful (hobbit for invented characters), trademark law deliberately leaves the non-source identification functions of symbols to the vagaries of public discourse. The non-source identification functions of symbols, of course, affect whether a term is deceptive, disparaging, descriptive, arbitrary, etc. for particular goods or services (e.g., apple for lipstick versus apple for computers). Thus, the non-trademark meaning of a term necessarily becomes part of the trademark analysis. Nonetheless, trademark law only provides rights in the source-identification aspect of a symbol. An applicant's interest, correspondingly, is solely in obtaining those rights, and not in claiming rights in any non-source-related meaning of a symbol.

Because the trademark function can be separated from the other communicative functions of a symbol, the registration system can operate without having harmful effects on those other functions.[13] The content of expression is important to figuring out if a symbol is capable of being a trademark, but denying trademark rights regulates only the commercial aspects of the speaker's message. Denial of registration relates to the

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[13] This Court has made a related distinction in cases in which commercial speech is not "inextricably intertwined" with noncommercial speech, allowing the commercial elements to be regulated under *Central Hudson*. *See Bd. of Trs. of State Univ. of N.Y. v. Fox*, 492 U.S. 469, 474 (1989).

source meaning of a symbol, but does nothing to regulate use of the symbol in any other way, even if – indeed, especially if – the bar applies to symbols with particular non-source-related meaning. If the trademark owner wants to communicate other things about itself (including "we wish to reclaim a slur"), it can use other symbols in conjunction with its mark.

B. The Disparagement Bar Does Not Impose An Unconstitutional Condition.

Denying rights to register based on a symbol's non-trademark meaning is necessarily at the core of many registration refusals, but not because of any discrimination against viewpoints or "penalty" for speech. Denial of registration occurs because Congress has determined that certain non-trademark meanings make symbols inappropriate for registration as a trademark, whether that's because of deception, interference with competition, or interference with the interests of others engaged in commerce (an interest common to the bans on registration of personal names without consent and on disparagement). As long as everyone is allowed to use a term in non-trademark ways, trademark law is not regulating or suppressing either the registrant or nonregistrants' uses in anything other than the trademark sense.

1. The Government Is Not Leveraging Refusal Of Registration For Speech Outside The Registration Program; Applicants Remain Free To Use Any Symbols They Wish.

Unconstitutional conditions doctrine regularly struggles to determine what counts as coercion, or as the appropriate baseline from which to measure an entitlement. *See* Kathleen M. Sullivan, *Unconstitutional Conditions*, 102 Harv. L. Rev. 1413, 1420 (1989) ("[D]eciding under what circumstances government offers, like private offers, are coercive is an inevitably normative inquiry."). The Federal Circuit chose the wrong baseline when it declared § 2(a) to impose an unconstitutional condition, *In re Tam*, 808 F.3d at 1339-41, because trademark registration is in its entirety about regulating speech: who gets to register which communicative symbols. The baseline against which to measure § 2(a) therefore cannot be whether the government interferes with a speaker's communication.

Under § 2(a), any speaker can continue to use any symbol it wants for communicating anything it wants, but it can only get a registration for matter that does not run afoul of a statutory exclusion. This distinction – which allows the government to regulate the mark's registration, but not to exercise any leverage over the speaker's other speech – is consistent with the leading unconstitutional conditions cases. In *Rust v. Sullivan*, 500 U.S. 173 (1991), the Court explained that unconstitutional conditions generally involve "situations in

which the Government has placed a condition on the *recipient* of the subsidy rather than on a particular program or service, thus effectively prohibiting the recipient from engaging in the protected conduct outside the scope of the federally funded program." *Id.* at 197. This Court more recently repeated its distinction between conditions that specify what activities Congress wants to subsidize (legitimate) and those that seek to leverage the subsidy to affect speech outside the government program (illegitimate). *Agency for Int'l Dev. v. All. for Open Soc'y Int'l, Inc.*, 133 S. Ct. 2321, 2328 (2013); *see also* Ramsey, *supra*, at 858-59.

The *Tam* en banc majority noted that, in many cases, an applicant whose application is denied will choose a new trademark. *In re Tam*, 808 F.3d at 1341. This consequence should not affect the constitutional analysis for two reasons: First, choosing a new mark does not mean that the applicant will cease using the registration-barred symbol *as a symbol* if it has an expressive reason for continuing to do so. While the *In re Tam* majority claimed that trademark owners could not "realistically have two brand names, one inoffensive, non-disparaging one (which would be able to secure registration) and a second, expressive, disparaging one (which would be unregistrable and unprotectable)," 808 F.3d at 1351, that dual system of official and unofficial names is in fact common in the real world. We speak of the famous judge Learned Hand, but his friends knew him as Bunny; Stefani Germanotta has not changed her legal name, but is generally

known by her stage name, Lady Gaga. Ronald Reagan National Airport is still known to locals as National. Many national sports teams are easily recognizable by their unofficial nicknames. *See, e.g.*, https://en.wikipedia.org/wiki/List_of_baseball_team_nicknames. Many brands also make unprotectable generic terms large parts of their branding because they desire the communicative benefits of those terms even absent registrability: Subway's FOOTLONG is a highly visible example. *Sheetz v. Doctor's Ass., Inc.*, 108 U.S.P.Q.2d 1341 (T.T.A.B. 2013). Slogans can be protected separately from names. Relatedly, trade dress and logos can provide valid, protectable marks if a name is unregistrable. For instance, in the case of the Washington football team, were it to ultimately have its REDSKINS registrations cancelled, it could continue to protect its goods and services through its other many registrations such as its stylized R mark and its logo marks.[14] Thus, the sandwich shop and the football team both illustrate how a markholder can use other, registrable marks to receive the full range of government benefits.

Second, chilling effects or disincentives are a common effect of a failure to subsidize or supply a benefit, but are not constitutionally problematic so long as they are not designed to limit speech outside the subsidized program. *See, e.g.*, *Rust v. Sullivan*, 500 U.S. 173, 197 (1991) (upholding government's choice to subsidize

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[14] R Registration. No. 3,090,334 (stylized R logo for merchandise); Registration No. 2,902,746 (Indian head logo trademark for merchandise); Registration No. 1,861,766 (Indian head logo on a football helmet for merchandise).

childbirth, but not abortion); *Regan v. Taxation with Representation of Wash.*, 461 U.S. 540, 553 (1983) (Blackmun, J., concurring) (emphasizing charitable organizations' ability to lobby through affiliate organizations as a reason for upholding a tax exemption conditioned on avoidance of lobbying); *Machete Productions, L.L.C. v. Page*, 809 F.3d 281, 289-90 (5th Cir. 2015) (denial of film subsidy allegedly based on viewpoint did not impose unconstitutional condition where filmmaker was not prevented from making the film exactly as planned, only without a subsidy); Stephen R. Baird, *Moral Intervention in the Trademark Arena: Banning the Registration of Scandalous and Immoral Trademarks*, 83 Trademark Rep. 661, 695 (1993).

Denying Mr. Tam rights in *any* mark as long as his band kept the name THE SLANTS would be an unconstitutional penalty for the exercise of his First Amendment rights. Denying him the right to register any mark he wants is not. To analogize to *Walker v. Texas Division, Sons of Confederate Veterans*, 135 S. Ct. 2239 (2015), the speaker is free to put a Confederate flag bumper sticker on his bumper. He just cannot have it on the license plate. *See also Agency for Int'l Dev.*, 133 S. Ct. at 2329-30 (discussing ease of working around restriction as a reason to accept content-based nature of government program); *Regan*, 461 U.S. at 548-49 (upholding the subsidy of certain organizations for lobbying and noting the relatively simple work-around for unsubsidized organizations to get similar treatment). Under § 2(a), likewise, the band members can keep the name, use it as they like, and receive the benefits of

registration by relying on a non-disparaging logo or other symbol. They just cannot get the government's help by invoking only this particular disparaging symbol. *In re Tam*, 808 F.3d at 1381 (Reyna, J., dissenting). The government is not gaining any leverage over the message appearing outside the registered matter, any more than it has leverage over the message appearing on a bumper sticker because it has the power to approve or disapprove license plates. The government's unwillingness to take part in the disparaging or racist aspects of the message communicated by the mark can therefore itself be a sufficient interest to justify the bar. *Cf. In re Tam*, at 1379 (Reyna, J., dissenting) (noting the Lanham Act's goal, under the Commerce Clause, of assisting the free flow of commerce open to all).

The broader point is that, ultimately, the government *must* weigh in on the validity of a speaker's choice of marks if the mark is to be enforced against others. That is, because the entire system of trademark registration is a system of speech regulation, it is very different from the unconstitutional conditions cases finding that the government overstepped its bounds. Because the government is heavily involved in defining and enforcing trademark rights, its hands-off position to avoid the possibility that the government would be seen as validating disparagement should be held to be constitutional.

2. Unconstitutional Conditions Analysis Is Appropriate Because *Central Hudson* Scrutiny Cannot Properly Assess A Comprehensive Government Program That Requires Evaluation Of Speech To Function.

Assuming arguendo that trademark law only regulates commercial speech, the alternative to unconstitutional conditions is *Central Hudson* analysis (or strict scrutiny). But such scrutiny could not be limited to the disparagement bar. Many of the other bars, as well as other provisions of the Lanham Act, have features that are at least dubious under *Central Hudson* scrutiny, which assumes that the government is directly suppressing speech and therefore puts a relatively heavy burden on the government to justify its prohibitions. False or misleading commercial speech can simply be banned. Thus marks that create a false association under § 2(a), and marks that are deceptive or misdescriptive under § 2(a) or § 2(e)(3) are likely not protected speech (assuming that they are commercial speech). However, substantial issues of tailoring and evidence would remain. Because barring registration of deceptive marks is possible, then all the subject matter-specific, deception-adjacent bans would seem to fail the less restrictive means test. The less restrictive means already present in the statute is to make an individualized determination of deceptiveness rather than to deter all uses of marks within a class, even if that class runs a higher than average risk of being deceptive.

Likewise, the USPTO's use of inference and common sense, without considering the actual marketplace context of a mark's use that might eliminate deception in practice, may make deceptiveness refusals overinclusive. Moreover, as it stands, the USPTO can refuse registration even when the applicant shows that matter outside the applied-for mark makes actual deception unlikely, *e.g.*, *In re Volk Art, Inc.*, No. 74/693,416, 1998 WL 377661, at *4 (T.T.A.B. July 8, 1998), or when a term has a non-deceptive meaning that can be clarified by the rest of a product's packaging, *e.g.*, *In re Wadhwa*, No. 86023037, 2016 WL 1045678, at *2-6 (T.T.A.B. Feb. 16, 2016). If, as courts are beginning to suggest, prophylactic anti-confusion rules are not narrowly tailored enough to survive strict scrutiny, then trademark law's unwillingness to consider disclaimers outside the applied-for matter seems constitutionally suspect. *See Pursuing America's Greatness v. Fed. Election Comm'n*, 831 F.3d 500, 507-11 (D.C. Cir. 2016).

Separately, refusing registration does not stop the *use* of a symbol to deceive consumers, meaning that the harm inflicted on the applicant from denying the registration does not necessarily further the government's interest. Indeed, if the government's refusal is correct, then by hypothesis the applicant's use of a deceptive term is material to consumers, thus helping to sell the product. Even absent a registration, the applicant would therefore have every incentive to continue using the deceptive term. While an outright ban on the use of a deceptive term under false advertising law would

be appropriately tailored to the government's interest, refusing registration would not be.

The bar on registering marks confusingly similar to marks already registered or in use also seems, at first look, highly connected to deception. *See In re Tam*, 808 F.3d at 1329 (stating that such bars were constitutionally unproblematic). However, the standard under which the USPTO refuses registration does not take real likelihood of confusion into account, because it deliberately abstracts away from marketplace context, refusing to consider additional distinguishing features that in practice always appear next to a supposedly confusing mark. For example, if Tam's mark THE SLANTS is ultimately registered, an application to register THE SLANTS would be refused for a second band even if in reality the second band always accompanied the term with a clear distinguishing feature, such as "the really racist ones." Confusion for registration purposes will often be measured differently than confusion in the actual marketplace. *B&B Hardware, Inc. v. Hargis Indus., Inc.*, 135 S. Ct. 1293, 1308 (2015). The registration inquiry abstracts away from marketplace context in order to make the registration system work by providing a searchable, understandable list of the terms that are off-limits to other businesses. Having two separate registrations of THE SLANTS for identical services would be inconsistent with that systemic objective. However, administrative convenience is generally not a sufficient justification for limiting First Amendment rights – when the limit involves a ban on speech rather than a government-conferred benefit.

Other sensible registration bars, even the bar on registering merely descriptive marks, would also be extremely vulnerable under *Central Hudson* or strict scrutiny taken seriously. *See* Rebecca Tushnet, *The First Amendment Walks into a Bar: Trademark Registration and Free Speech*, 91 Notre Dame L. Rev. (forthcoming 2016) (manuscript at 22-23) (available at https://papers.ssrn.com/sol3/papers.cfm?abstract_id=2745016); *see also* Snow, *supra*, at 125-30 (discussing other trademark issues, such as priority and infringement, that would also face invalidity). For instance, under § 2(c), a flag is not registrable when it forms part of a mark even where there is no suggestion of affiliation with the government that flag represents. Such exclusions from registration do not rest on any judgment that the mark is deceptive or likely to cause consumer confusion, nor do they protect the markholder's investment in his mark.

The widespread chaos that the decision below would cause in registration, and trademark law more generally, if applied according to its own terms, demonstrates that it is inappropriate to use a test about suppressing speech to evaluate whether the government can refuse to give a registration, or even a private right of action, to a commercial speaker.

3. Analogies To Copyright Are Flawed.

In striking down the § 2(a) disparagement bar, the Federal Circuit analogized to copyright law. *In re Tam*, 808 F.3d at 1346-48. Unlike trademark law, however,

copyright protects the expression in a work. Therefore, in copyright, to mandate that a work of authorship be non-disparaging or non-obscene to get protection would be to target the content of the work itself as a condition of the benefits of protection.[15] *See* Ramsey, *supra*, at 879-81 (elaborating relevant distinctions between the regimes). Trademark law is different because it protects only the source identification function of a symbol and not the symbol itself. Thus, any business can continue to use the symbol for which the government refuses registration, even for the very products and services for which it sought registration, and still have its trade interests protected, if it also chooses some other symbol to make the link between itself and its goods and services.[16] Mr. Tam's speech is unaffected, and the government's interest in avoiding

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[15] Because copyright protects only expression, and not ideas, barring protection for disparaging works might well impose an unconstitutional condition insofar as it reached outside the government-provided benefit for expression to penalize the speaker's ideas. In addition, just as with trademark, denying copyright protection on the basis of the *speaker's* viewpoint would be unconstitutional.

[16] The trademark function also distinguishes registration from New York's unconstitutional "Son of Sam" law, which allowed the state to escrow money received from a criminal's expression about his crimes. *Simon & Schuster, Inc. v. Members of the N.Y. State Crime Victims Bd.*, 502 U.S. 105, 108 (1991). Even assuming there is a constitutional right to profit from one's expression, Tam's band can perform under the name Slants without financial sanction, and with trademark protection for other symbols, and the government will not escrow the resulting income nor tax the sales any differently than it does for other sales.

any appearance of endorsement of discrimination in commerce is also satisfied.

Moreover, the Federal Circuit failed to appreciate that the government could indeed withdraw or refuse to grant copyright protection to categories of works (as it has done) without violating the First Amendment. Architectural works, for example, were excluded from copyright protection for two centuries with no First Amendment problems; sound recordings were excluded for decades; perfume, yoga, gardens, and other forms of creative works are still excluded. These examples demonstrate that current copyrightability rules are indeed content-based. *See, e.g.*, *Kelley v. Chi. Park Dist.*, 635 F.3d 290 (7th Cir. 2011); *see also Compendium of U.S. Copyright Office Practices (Third)* (2014) §§ 313.6(c), 806.5(B)(3) (including, among other things, functional physical movements (like yoga), social dances, bridges, interior design, and landscape design as noncopyrightable subject matter) http://www.copyright.gov/comp3/docs/compendium.pdf; Christopher Buccafusco, *Making Sense of Intellectual Property Law*, 97 Cornell L. Rev. 501, 540-41 (2012). The relevant question is whether the exclusions are sufficiently related to a legitimate purpose for the government's program, and this legitimate purpose may come from the categories of creative activity the government wishes to encourage.

III. VAGUENESS IS NOT AN INDEPENDENT REASON TO INVALIDATE THE DISPARAGEMENT BAR.

As with many other trademark determinations, the application of § 2 results in inevitable errors and inconsistencies. For example, WHITE PRIDE COUNTRY WIDE[17] was refused registration as disparaging while ASIAN PRIDE and BLACK PRIDE[18] were registered. There are, however, several reasons not to conclude that these inconsistencies indicate a vague standard. First, inconsistencies naturally result from contextualization. The examiner assembles evidence of what a particular term means in the context of the applied-for goods or services, and the evidence of the meaning of a term to a substantial composite of the referenced group may differ even for related terms. Context changes our understanding of words; inoffensive words become offensive and vice versa based on context. Farley, *Stabilizing Morality in Trademark Law*, 63 Am. U. L. Rev. at 1039 ("[C]ontextualization leads to inconsistent results by design; it is inherent in the exercise.").

Second, the USPTO treats every application on its own merits – for all issues, not just when they raise § 2(a) disparagement concerns. *See, e.g.*, *In re Nett Designs, Inc.*, 236 F.3d 1339, 1341-42 (Fed. Cir. 2001); *In re Couriaire Express Int'l, Inc.*, 222 U.S.P.Q. 365, 366

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[17] WHITE PRIDE COUNTRY WIDE, Serial No. 78368298.

[18] ASIAN PRIDE, Registration No. 2,089,064; BLACK PRIDE, Registration No. 1,573,602.

(T.T.A.B. 1984) ("That each case must be determined on its own facts is a proposition so well established that no authority need be cited in support of it."). Third, since the applicant is responsible for presenting evidence, similar terms may be evaluated with different evidentiary records leading to different results. *See, e.g.*, *McDermott v. S.F. Women's Motorcycle Contingent*, 240 Fed. App'x 865, 866 (Fed. Cir. 2007) (recounting the initial refusal and subsequent successful registration after applicant submitted evidence that lesbians would not perceive the mark as disparaging).

Finally, touted examples of apparent inconsistency are selected from the millions of applications submitted to the USPTO. The registration system requires hundreds of examiners and attracts hundreds of thousands of applications per year. U.S. Patent & Trademark Office, Performance and Accountability Report Fiscal Year 2015, https://www.uspto.gov/sites/default/files/documents/USPTOFY15PAR.pdf at 198 tbl. 16 (showing over 300,000 applications filed and approved for publication in Fiscal Year 2015). This scope should influence the standards by which the system is judged. As long as the USPTO applies the correct legal standard, apparent differences in the outcome of similar applications do not represent a fatal constitutional flaw. Asking the hundreds of examiners (at any given time) for more than rough consistency in results would be like asking America's public school teachers to make their content-based assessments of English papers with enough precision that they would all give the same grades to the same papers.

The inevitable inconsistency between some selected cases in a merits-based system is, indeed, one reason why the Court has granted government flexibility in making content-based decisions in analogous situations. Many government grant programs could not survive if required to be strictly consistent in every case, and the benefits of having trademark registration (or public school teachers) are great enough to justify the inevitable inconsistencies. This is what it means to have a regulatory state. If the government is going to maintain a trademark system granting the benefits of registration after substantive examination, it needs flexibility and tolerance that is inconsistent with traditional strict scrutiny or even heightened *Central Hudson*-style scrutiny.[19]

The risks of First Amendment scrutiny should be particularly apparent with respect to the argument that disparagement is unconstitutionally vague. If vagueness is a constitutional flaw in disparagement, then the list of potential vagueness challenges will be long. Indeed, similar inconsistency plagues most of the other bars; distinctions between inherently distinctive,

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[19] *Cf. National Endowment for the Arts v. Finley*, 524 U.S. 569, 585 (1998) ("Any content-based considerations that may be taken into account in the grant-making process are a consequence of the nature of arts funding. The NEA has limited resources, and it must deny the majority of the grant applications that it receives, including many that propose 'artistically excellent' projects."). The PTO's resources are not limited in the same way as those of the National Endowment for the Arts, but the "nature" of its endeavor equally requires multiple content-based determinations assessing the meaning of a specific mark in its specific context.

immediately registrable marks, descriptive marks that can only be registered upon a showing of secondary meaning, and generic terms that can never be protected as marks; the "use as a mark" precedents requiring trademark use instead of ornamental use for registration; and the infringement standards themselves.

There is, for example, a circuit split on the question of whether CHICKEN OF THE SEA is inherently distinctive or descriptive when used for tuna. *Compare Van Camp Sea Food Co. v. Packman Bros.*, 79 F.2d 511, 511-12 (3d Cir. 1935) (per curiam) (descriptive), *with Van Camp Sea Food Co. v. Alexander B. Stewart Orgs.*, 50 F.2d 976, 979 (C.C.P.A. 1931) (suggestive). Many cases note the difficulty of marking the line between suggestive, descriptive, and generic terms. *See, e.g.*, *Thompson Med. Co. v. Pfizer Inc.*, 753 F.2d 208, 213 (2d Cir. 1985) ("It cannot be gainsaid that the judiciary is ill-equipped to distinguish between the descriptively suggestive and the suggestively descriptive mark. In addition, societal vicissitudes demand that the categories retain fluidity to accommodate a particular mark's evolving usage over time. . . . [I]t is necessary to surmise the mental processes of those in the marketplace at whom the mark is directed." (footnote omitted)); *AMF, Inc. v. Sleekcraft Boats*, 599 F.2d 341, 349 (9th Cir. 1979) ("The line separating [suggestive and descriptive marks] is uncertain; extrapolating the line from precedent would be impossible. . . . [T]he distinction between descriptive and suggestive marks may be inarticulable. . . ."); *Thompson Med. Co.*, 753 F.2d at

213 n.8 ("[B]ecause generic marks cannot be protected even upon a showing of secondary meaning, courts increasingly have been called upon to delineate the chimerical line between the descriptive and the generic."). Examples could be multiplied indefinitely. *See* Snow, *supra*, at 156-58 (noting that other bars are also vague and uncertain); Tushnet, *supra*, at 33-35; *cf.* 2 Thomas J. McCarthy, *McCarthy on Trademarks and Unfair Competition* §§ 11:24, 11:72 (4th ed. 2016) (listing examples of marks found suggestive and merely descriptive).

While most of the hundreds of thousands of trademark registration determinations made every year are never challenged outside of the USPTO, they do involve content-based evaluations of specific symbols. Given the size of the system and its need to balance rights among different applicants, competitors, and the general public, general principles of administrative law, not the rules of strict scrutiny, are more appropriate for assessing the performance of the system.

CONCLUSION

The decision below – that all content-based trademark rules must survive strict scrutiny – would wreak havoc on trademark law. The Federal Circuit's treatment of the Lanham Act's regulatory scheme as presumptively unconstitutional is misguided because it wrongly treats trademark registration refusal as a ban on speech. Trademark law is pervasively content-based, but that is not a fatal flaw for a government

program. Because § 2 disparagement is a concept that could apply to anyone, the ban on disparaging marks is more appropriately characterized as content-based rather than viewpoint-based. Under the appropriate analytic framework, the bars of § 2 reflect acceptable judgments about which symbols should receive legal protection as source identifiers, not penalties imposed on an actor doing business independently of the government. The Court should reverse the decision below.

Respectfully submitted,

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